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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,920	12/11/2001	Albert C. Ting	VGEN.005A	7542

20995 7590 01/27/2003

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EXAMINER

GILPIN, CRYSTAL M

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 01/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/017,920

Applicant(s)

TING ET AL.

Examiner

Crystal M Gilpin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 and 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement filed on 4 November 2002 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but document numbers: 10/207208, 10/207718, 10/207701, 10/207688, 10/207717 have not been considered.

It is further suggested that pending documents be listed under the section entitled –Other Documents–.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

1. Claims 1, 3, 4, 5, 7, 9, 10, and 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Portney (USPN 6,179,058).

Regarding claims 1, 4, 7, and 9, Portney teaches of an intraocular lens with an optical axis (Fig. 1a, Ref. Num. 32) and a secondary or anterior portion (Fig. 2, Ref. Num. 64) and primary or posterior portion (Fig. 2, Ref. Num. 62) both made of refractive material (Column 2, lines 19-22). The primary or posterior portion has a diameter larger than that of the anterior

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portion (Column 9, lines 35-36) and a central section (Fig. 2, Ref. Num. 76) that extends radially from the optical axis has a range of negative to positive refractive power, (Column 7, Lines 40-49).

Regarding claims 3, 5 and 10, Portney teaches that the anterior portion has a diameter no greater than 7 mm, which includes the range of about 3 mm or less. Portney further teaches that the anterior portion has a diopter range less than 30 diopters, from -2.5 to +2.5, which includes a refractive power of zero (Column 7, Lines 50-58).

Regarding claim 12, either of the primary or secondary viewing elements are implantable and therefore inherently removable.

Regarding claims 13 and 14, Portney teaches that the primary viewing element includes a frame with a narrow recess or groove for the detachable attachment of the secondary viewing element (Column 8, lines 15-18, Fig. 3, Ref. Num. 74)), where the secondary viewing element has a frame attached to it (Fig. 2, Ref. Num. 80).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2, 6, 8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Portney (USPN 6,179,058).

Regarding claims 2 and 8, Portney discloses an intraocular implant with an secondary or

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anterior optic diameter no greater than 7 mm. Portney does not disclose expressly that the diameter is 3 mm or less. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to limit the diameter of the optic to less than 3 mm because Applicant has not disclosed that a diameter of 3 mm or less provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with a diameter of less than 7 mm, as long as it is smaller than the primary or posterior optic.

Therefore, it would have been an obvious matter of design choice to modify Portney to obtain the invention as specified in claims 2 and 8.

Regarding claims 6 and 11, Portney discloses an intraocular implant with a posterior optic that has a diopter range between -10 and +35 diopters (Column 7, Lines 40-49). Portney does not disclose expressly that the refractive power is about 20 diopters. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to specify the refractive power as about 20 diopters because Applicant has not disclosed that a refractive power of about 20 diopters provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with a range of -10 to +35 diopters in order to accommodate the patients focusing needs.

Therefore, it would have been an obvious matter of design choice to modify Portney to obtain the invention as specified in claims 6 and 11.

3. Claims 1, 4, 6, 7, 9, and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turley (USPN 4,892,543).

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Regarding claims 1, 4, 6, 7, 9, and 11, Turley teaches of an intraocular implant with a first or anterior portion (Fig. 2, Ref. Num. 42) and a second or posterior portion of a larger radial diameter (Fig. 2, Ref. Num. 44) along an optical axis (Fig. 2, Re. Num. 102). Turley further teaches that the anterior portion has a fixed refractive power of about 30 diopters (Column 3, lines 19-30) and that the posterior portion has a variable refractive power to accommodate the varying focal needs of the patient. Turley does not expressly disclose a diopter range or that the refractive power of the posterior lens is positive (As set forth in Claim 1) or negative (As set forth in Claim 4). At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to provide a range of refractive power because Applicant has not disclosed that a positive or negative refractive power provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with variable refractive power to accommodate to the focusing needs of the patient.

Therefore, it would have been an obvious matter of design choice to modify Turley to obtain the invention as specified in claims 1, 4, 6, 7, 9 and 11.

Regarding claims 12-14, Turley teaches that the posterior portion of the intraocular implant has a ring section or frame to stabilize the lens (Fig. 3, Ref. Num. 64). Turley lacks the teaching of a frame that defines a void, however it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Turley to provide a frame with a void for connection to a removable optic.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Crystal M Gilpin whose telephone number is 703-305-8122. The examiner can normally be reached on M-F, 9:00-5:00 (Second Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 703-308-2111. The group fax phone number for the organization where this application or proceeding is assigned are 703-305-3590.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

cmg
January 22, 2003


Paul B. Prebille
Primary Examiner